

REMARKS

Claims 1, 4 to 7, 10, 12, 13, 15, 16, 20, and 22 to 35 remain pending. Claims 3 and 14 have been cancelled.

Claims 1, 3 to 7, 10, 12 to 16, 20, and 22 to 30 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The use of the term "compound" in claims 1, 12 to 16, and 26 to 28 was deemed confusing. Claims 20 and 22 depend on a cancelled claim.

The rejection of claims 1, 4 to 7, 10, 12, 13, 15, 16, 20, and 22 to 30 under 35 U.S.C. 112, second paragraph, is traversed in view of the claim amendments to claims 1, 12, 13, 15, 26, and 27.

The rejection of claims 3 and 14 under 35 U.S.C. 112, second paragraph, is moot since they have been cancelled.

Claims 1, 3 to 7, 10, 12 to 16, 10(?), and 22 to 30 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,224,851 B1 to Bara et al. (the Bara patent) in view of the Occupational Safety & Health Administration website page entitled "Chemical Sampling Information; Ethyl Perfluorobutyl Ether" (the OSHA publication), JP 356079613A to Tsutsumi et al. (JP '613), and U.S. Patent No. 6,528,070 B1 to Bratescu (the Bratescu patent).

The Action states that the Bara patent discloses a water-in-oil cosmetic composition having 20 wt% perfluoromethylcyclopentane. The Action states that the Bara patent discloses the replacement of perfluoromethylcyclopentane with ethoxynonafluorobutane. The Action states that

ethoxynonafluorobutane is available as ethoxy perfluorobutane, another name for perfluorobutyl ether. The Action states that it is prima facie obvious to combine perfluorobutyl ether and perfluoromethylcyclohexane since they are used for the same purpose in the art. The Action states that the disclosed fluorinated solvents have a vapor pressure greater than 20 mbar at 25° C and boiling points between 20° C and 75° C. The Action alleges that the Bara patent suggests that perfluoromethylcyclopentane and ethoxy- and methoxynonafluorobutane are within this limitation. The Action admits that the Bara patent is silent as to specific vapor pressure of the volatile perfluoro solvents. The Action also admits that the Bara patent does not disclose the texture or specific viscosity of the composition. The Action discloses that ethyl perfluorobutylether has a vapor pressure of 109 mm Hg (145.32 mbar) at 25° C.

The Action states that the Tsutsami patent discloses that a whipped stable cosmetic that is "without oil off and shape collapse" is well known in the art. The Action admits the Tsutsami patent does not disclose using an aerosol container. The Action states that the Bratescu patent discloses a cosmetic emulsion and that viscosity can vary from 100 cps to 80,000 cps.

The Action stated that it would have been obvious to modify the composition of the Bara patent by producing a whipped composition as motivated by the JP '613 because both references disclose cosmetic emulsions and cream form, because the JP '613 discloses the benefit of stability in terms of phase separation and shape without using emulsifiers, and the reasonable success of producing a stable, whipped cosmetic emulsion. The Action stated that it would also have been obvious to have adjusted the

viscosity of the composition of the combined references as motivated by the Bratescu patent.

The rejection of claims 1, 3 to 7, 10, 12 to 16, 10(?), and 22 to 30 under 35 U.S.C. 103(a) over the Bara patent in view of the OSHA publication, JP '613, and the Bratescu patent is traversed in view of the amendments to independent claims 1 and 26. The combination of references neither yields the claimed invention or is suggested by the teachings of the references themselves as described below.

The Bara patent discloses transfer-resistant makeup and sunscreen compositions. The Bara patent discloses anhydrous compositions (col. 5, lines 53 to 59 and col. 6, lines 18 to 20) and emulsion compositions (col. 6, lines 11 to 25). Anhydrous compositions can take the form of an oily gel; a compacted or cast powder; a cream; a stick, such as a lipstick; foundation; mascaras; eyeliners; eyeshadows; or blushes. Example 1 is an anhydrous lipstick. Emulsion compositions can be oil-in-water or water-in-oil. Example 2 is a water-in-oil emulsion taking the form of a foundation.

The combination of cited references does not yield the claimed invention because the amended claims more particularly distinguish the Bara patent. Independent claims 1 and 26 now require the composition to be an oil-in-water emulsion, to have an emulsifier, and be a cream. The Bara patent does not specifically disclose a composition that is both an oil-in-water emulsion and a cream. The cream form is described as preferred (col. 7, lines 7 and 8) but is not specifically associated with an oil-in-water emulsion form. Further, neither example in the Bara patent discloses such a composition. Thus, obtaining an oil-in-water emulsion in cream form requires picking and choosing

and/or hindsight reconstruction in view of unspecified, hypothetical embodiments of the composition of the Bara patent. It is even more unlikely when the disclosure of the Bara patent is to be combined with three other references in hopes of yielding the claimed invention.

The combination of references is not suggested by the teachings of the references themselves. The combination relies on JP '613 to provide suggestion to modify the composition of the Bara patent to produce a stable, whipped emulsion without using emulsifiers. The pertinent portion of the Action is recited as follows:

"2) Tsutsumi teaches the benefit of stability of the composition in terms of phase separation and shape without using emulsifiers; 3) and the skilled artisan would have had a reasonable expectation of successfully producing a stable whipped cosmetic composition." (page 5, last paragraph of the Action)

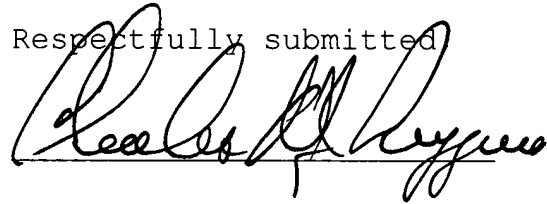
As admitted in the Action, the composition of Tsutsumi (JP '613) does not have an emulsifier. This is further evidenced by the text of the enclosed translation of JP '613 at page 4, line 7. Since claims 1 and 26 require an emulsifier, combination of the Bara patent and the JP '613 contradicts the teachings of JP '613, and, thus, is not suggested. Since the combination of the Bara patent and JP '613 is not suggested, the entire reference combination, all four cited references, falls. It is also noted that the cited Bratescu patent discloses emulsions having an emulsification system having at least one cationic surfactant, at least one anionic surfactant, and at least one bridging surfactant. Thus, the combination of JP '613 and the Bratescu patent contradicts the teachings of JP '613, and, thus, is likewise not suggested.

The rejection of claims 3 and 14 under 35 U.S.C. 103(a) is moot since they have been cancelled.

Reconsideration of claims 1, 4 to 7, 10, 12, 13, 15, 16, 20, and 22 to 35 is deemed warranted in view of the foregoing, and allowance of said claims is earnestly solicited.

Dated: March 17, 2005

Respectfully submitted

A handwritten signature in black ink, appearing to read "Charles N. J. Ruggiero", written over a horizontal line.

Charles N. J. Ruggiero
Reg. No. 28,468
Attorney for Applicants
Ohlandt, Greeley, Ruggiero
& Perle, L.L.P.
One Landmark Square
Stamford, CT 06901-2682
Tel: 203-327-4500